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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,166	06/28/2003	Rajendra Kashinath Singh	GEPL.P-072	1165

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EXAMINER

YOON, TAE H

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/604,166

Applicant(s)

SINGH ET AL.

Examiner

Tae H. Yoon

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 24 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This is New Matter rejection since the recited ratio of "2 to 25" does not have support in [0028] contrary to applicant's statement. Said [0028] shows "about 2 to 25" instead.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 20-26 of U.S. Patent

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No. 6,353,046 in view of US 5,606,007 and 6,136,945. Although the conflicting claims are not identical, they are not patentably distinct from each other because the flame retardant polycarbonate containing the instant perfluoroalkane sulfonate and cyclic siloxane of said patent No. 6,353,046 inherently would meet the recited V0 UL flammability rating and % haze since the mandatory components are same and since the instantly recited acidic quencher which neutralizes the basic catalyst in producing a polycarbonate is inherent in said patent No. 6,353,046 as evidenced by US 5,606,007 (example 1) recited at col. 2, line 14 of said patent No. 6,353,046 and since the use of acidic quenchers is well known practice as evidenced by said patent No. 6,136,945 (col. 3, lines 11-21 and table 1).

The rejection is maintained since applicant failed to provide any support (such as MPEP or case law) that 102(b) reference cannot be used in obviousness-type double patenting rejection.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rosenquist et al (US 6,353,046) in view of Sakashita et al (US 5,606,007) and Mestanza (US 6,136,945).

Rosenquist et al teach the flame retardant polycarbonate containing the instant perfluoroalkane sulfonate and cyclic siloxane in abstract, examples and claims 1-4 and 20-26. Example 2 (tables 2A and 2B) show the instant UL 94 V0 and 5 haze. A thickness of 75 mil is 1.9 mm. Said example would meet the UL 94 V0 at a thickness of 1.6 mm inherently. With respect to the acidic quencher, the use of said acidic quencher in producing polycarbonates is a routine practice in the art as taught by Sakashita et al (example 1) and Mestanza (table 1) since it improves % haze and yellowness index.

It would have been obvious to one skilled in the art at the time of invention to utilize the acid quenched polycarbonates of Sakashita et al and Mestanza in Rosenquist et al since Rosenquist et al teach the polycarbonates of Sakashita et al and since the use of said acidic quencher in producing polycarbonates is a routine practice in the art as taught by Sakashita et al (example 1) and Mestanza (table 1) since it improves % haze and yellowness index.

The rejection is maintained with following response.

Applicant asserts that the examiner fail to address the base to quencher ratio, but the example 1 of Sakashita et al teaches a molar ratio of 5 contrary to applicant's assertion.

Applicant also asserts that tables 1 and 2 show unexpected result, but said table 2 shows V2 UL rating for a ratio of 1.2 (batch 2) being recited in claim 1. Batch 3 of said table 2 shows V0/V1 UL rating for a ratio of 18.3 being recited in claim 1.

Also, the base and acidic quencher of claims are broader than the actual showing in examples.

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mark et al (US 4,130,530) in view of Rosenquist et al (US 6,353,046) and Nouvertne (US 3,775,367), and further in view of Sakashita et al (US 5,606,007) and Mestanza (US 6,136,945).

Mark et al teach polycarbonate composition plasticized with the instant cyclic siloxane at col. 1, line 44 to col. 2, line 3 and in examples. The instant invention further recites employing a flame retardant component, a potassium perfluoroalkane sulfonate, and the use of an acidic quencher over Mark et al. However, the use of said potassium perfluoroalkane sulfonate (as a flame retardant) in polycarbonates is well known practice in the art as taught by Rosenquist et al (col. 4, lines 9-10 and examples) and Nouvertne (col. 2, lines 26-45 and examples). Also, the use of said acidic quencher in producing polycarbonates is a routine practice in the art as taught by Sakashita et al (example 1) and Mestanza (table 1) since it improves % haze and yellowness index.

It would have been obvious to one skilled in the art at the time of invention to utilize the art well known flame retardant such as potassium perfluorobutane sulfonate for polycarbonates of Rosenquist et al and Nouvertne and the acid quenched polycarbonates of Sakashita et al and Mestanza in Mark et al since Mark et al teach employing other materials at col. 4, lines 9-13 and since polycarbonates are inherently flammable as taught by Rosenquist et al (col. 1, lines 9-10) and since the use of said acidic quencher in producing polycarbonates is a routine practice in the art as taught by Sakashita et al (example 1) and Mestanza (table 1) since it improves % haze and yellowness index.

The rejection is maintained with following response.

Applicant asserts that the examiner fail to address the base to quencher ratio, but the example 1 of Sakashita et al teaches a molar ratio of 5 contrary to applicant's assertion.

Applicant also asserts that tables 1 and 2 show unexpected result, but said table 2 shows V2 UL rating for a ratio of 1.2 (batch 2) being recited in claim 1. Batch 3 of said table 2 shows V0/V1 UL rating for a ratio of 18.3 being recited in claim 1.

Also, the base and acidic quencher of claims are broader than the actual showing.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tae H Yoon
Primary Examiner
Art Unit 1714

THY/December 27, 2005